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EXAMINER

MENBERU, BENIYAM

ART UNIT	PAPER NUMBER
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2626

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/881,402	Applicant(s) KAGAWA, TETSUYA	
	Examiner Beniyam Menberu	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Response to Arguments***

1. Applicant's arguments, see pages 24-32, filed March 31, 2005, with respect to the rejection(s) of claim(s) 1, 23, and 45 under U.S. Patent No. 6002490 to Suzuki have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 5696598 to Yoshida et al for claims 1, 23, and 45. With respect to claim 67, Yoshida et al disclose of transferring to color facsimile machine. Further Yoshida et al teaches of color receiving and color recording facsimile machine (column 19, lines 20-26; column 31, lines 51-55).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 23, 45, 67, 68, 71, and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5696598 to Yoshida et al.

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Regarding claims 1, 23, and 45, Yoshida et al discloses a communications terminal apparatus and method, comprising:

- a communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine (column 18, lines 43-67);
- a registering mechanism configured to register an address and a communications capability of said transfer communications machine (column 17, lines 18-30);
- a notifying mechanism configured to notify of said communications capability of said transfer communications machine registered in said registering mechanism (column 12, lines 62-64 ; column 30, lines 40-48); and
- a controlling mechanism configured to instruct said notifying mechanism to notify said sending communications machine of said communications capability at a beginning of communications (column 12, lines 60-65; column 30, lines 41-45) and to instruct said communications mechanism to transfer image information received from said sending communications machine to said transfer communications machine using said address stored in said registering mechanism (column 23, lines 56-67; column 24, lines 1-2; column 5, lines 60-62; column 4, lines 1-4; column 19, lines 23-30)

Regarding claim 67, Yoshida et al disclose a method comprising:

- receiving a fax transmission at a receiving fax machine (column 18, lines 53-56);
- checking through an automated process if the fax transmission contains color image information (column 19, lines 15-17); and if said checking determines that

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the fax transmission contains color image information, transferring at least the color image information, through an automated process, from the receiving fax machine to a transfer fax machine that has color printing capabilities for printing of said color image information (column 19, lines 20-26; column 31, lines 51-55; Thus Yoshida discloses of a color recording and color receiving facsimile).

Regarding claim 68, Yoshida et al teach all the limitations of claim 67. Further, Yoshida et al disclose a method in which said transferring is by fax transmission from the receiving fax machine to the transfer fax machine (column 18, lines 63-66).

Regarding claim 71, Yoshida et al teach all the limitations of claim 67. Further, Yoshida et al disclose a method in which said transferring includes generating contact information identifying said transfer fax machine on the basis of information stored at said receiving fax machine before said transmission (column 5, lines 55-64).

Regarding claim 72, Yoshida et al teach all the limitations of claim 71. Further, Yoshida et al disclose a method in which said generating of contact information includes selecting said transfer fax machine from a plurality of fax machines which contact information has been stored at the receiving fax machine (column 5, lines 38-50, lines 56-62).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 4, 6, 24, 25, 26, 28, 46, 47, 48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6587219 to Saito et al.

Regarding claims 2, 24, and 46, Yoshida et al disclose a communications terminal apparatus and method, comprising:

A communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine (column 18, lines 53-61);

A registering mechanism configured to register an address and a communications capability of said transfer communications machine (column 5, lines 52-55);

A memory storing a set of image parameters (column 3, lines 65-67; column 4, lines 1-4);

A notifying mechanism configured to notify of said communications capability of said transfer communications machine (column 12, lines 62-64); and

A controlling mechanism configured to instruct said notifying mechanism to notify said sending communications machine of said communications capability at a beginning of communications (column 12, lines 60-65; column 30, lines 40-43) and to instruct said communications mechanism to transfer image

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information received from said sending communications machine to said transfer communications machine using said address and said set of image parameters stored in said memory (column 23, lines 56-67; column 24, lines 1-2; column 5, lines 60-62; column 4, lines 1-4). However Yoshida et al does not disclose a mechanism for notifying of an enhancement communications capability of said apparatus.

Saito et al disclose a mechanism for notifying of an enhancement communications capability of said apparatus (The relay apparatus (Figure 2, reference 2) serves as the apparatus stated in this claim. (column 3, lines 40-44, lines 54-60)).

Yoshida et al and Saito et al are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine notification mechanism as taught by Saito et al with the system of Yoshida et al to implement an accurate communication mechanism.

The motivation to combine the reference is clear because updating of capability is necessary because the capabilities of the facsimile machine responsible for transferring data is useful before sending image data to the facsimile machine.

Regarding claims 3, 25, and 47, Yoshida et al in view of Saito et al teach all the limitations of claims 2, 24, and 46 respectively. Further Yoshida et al

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disclose an apparatus and method, wherein said image information includes color and/or mono-color gray-scale data (column 20, lines 30-34).

Regarding claims 4, 26, and 48, Yoshida et al in view of Saito et al teach all the limitations of claims 3, 25, and 47 respectively. Further Yoshida et al disclose an apparatus and method, further comprising an enabling mechanism for enabling a color image receiving function when said address and said communications capability of said transfer communications machine are registered in said registering mechanism (column 5, lines 52-55; column 6, lines 18-22).

Regarding claims 6, 28, and 50, Yoshida et al in view of Saito et al teach all the limitations of claims 2, 24, and 46 respectively. Further Saito et al disclose an apparatus and method, further comprising another communications mechanism configured to perform communications with a plurality of communications machines including a sending communications machine and a transfer communications machine (Saito et al shows two Internet Facsimile apparatus (Figure 2, reference 2) in communication with a sender (Figure 2, reference 1) and final destinations (Figure 2, reference 4)), wherein said apparatus separately uses said communications mechanisms for receiving and transferring (Figure 2, reference 2)), and wherein said controlling mechanism changes communications protocols for a transferring operation (Saito et al use an internet facsimile apparatus as a relay fax and because the final destination is a facsimile apparatus it is necessary to convert data to match the destination before transmission to the destination.



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Thus communication protocol and line is different for receiving(network) and transferring(telephone line)(column 4, lines 19-25. ) ) and accordingly converts said image parameters stored in said memory (Yoshida et al: column 8, lines 56-67).

6. Claims 5, 27, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6587219 to Saito et al further in view of U.S. Patent 6335966 to Toyoda.

Regarding claims 5, 27, and 49, Yoshida et al in view of Saito et al teach all the limitations of claims 2, 24, and 46 respectively. However Yoshida et al in view of Saito et al does not disclose an apparatus and method, wherein said controlling mechanism is configured to instruct said communications mechanism to communicate with said transfer communications machine to obtain said communications capability of said transfer communications machine when said communications capability of said transfer communications machine is registered in said registering mechanism.

Toyoda discloses an apparatus as defined in claim 2, wherein said controlling mechanism is configured to instruct said communications mechanism to communicate with said transfer communications machine to obtain said communications capability of said transfer communications machine when said communications capability of said transfer communications machine is registered in said registering mechanism (column 15, lines 44-50; column 6, lines 43-47).

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Yoshida et al, Saito et al, and Toyoda are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the controlling mechanism ability to gather communication capabilities of transfer machine with the system of Yoshida et al in view of Saito et al to implement an accurate facsimile transferring system.

The motivation to combine the reference is clear because the capabilities of a transfer machine is necessary to determine whether or not to transfer image data to a transfer machine.

7. Claims 7, 10, 11, 15, 16, 18, 29, 32, 33, 37, 38, 40, 51, 54, 55, 59, 60, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6587219 to Saito et al further in view of U.S. Patent No. 5818609 to Yamamuro.

Regarding claims 7, 29, and 51, Yoshida et al in view of Saito et al teach all the limitations of claims 6, 28, and 50 respectively. However Yoshida et al in view of Saito et al does not disclose an apparatus and method, wherein said controlling mechanism is configured to start to transfer said image information received from said sending communications machine to said transfer communications machine before a completion of receiving said image information from said sending communications machine.

Yamamuro discloses an apparatus and method wherein said controlling mechanism is configured to start to transfer said image information received from said sending communications machine to said transfer communications machine

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before a completion of receiving said image information from said sending communications machine (Yamamura discloses a system wherein the host computer is the sending device (Figure 1, reference 13) and the fax system comprising of a control unit (Figure 1, reference 11; column 2, lines 15-17) transfers data to an address specified by host (column 4, lines 58-59). Further image reception from host computer is interrupted when memory full occurs and image in memory of fax system is transferred to address before completion of image reception (column 4, lines 36-37, lines 40-42, lines 54-56, lines 58-61)).

Yoshida et al, Saito et al, and Yamamuro are combinable because they are in the similar problem area of transferring of image data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the image transferring mechanism of Yamamuro with the system of Yoshida et al in view of Saito et al to implement an efficient image data transferring mechanism.

The motivation to combine the reference is clear because the transfer facsimile machine does not have to wait until all the image data is received before getting any transfer image data.

Regarding claims 10, 32, and 54, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. Further Yoshida et al disclose an apparatus and method, wherein said controlling mechanism is configured to detect at the beginning of said communications that said image information is sent and to conduct a call initiation to said transfer communications machine when detecting that said

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image information is sent (column 23, lines 62-67; column 24, lines 1-2, lines 8-15).

Regarding claims 11, 33, and 55, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. Further Yamamuro discloses an apparatus and method, wherein said controlling mechanism is configured to detect that said transfer communications machine is busy and to then stop receiving said image information from said sending communications machine (column 4, lines 20-37).

Regarding claims 15, 37, and 59, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. Further Yoshida et al disclose an apparatus and method wherein said controlling mechanism is configured to transfer said image information in page units (column 23, lines 62-67; column 24, lines 1-6).

Regarding claims 16, 38, and 60, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. Further Yoshida et al disclose an apparatus and method wherein said controlling mechanism is configured to transfer said image information using a type of communications same as that used to receive said image information with said communications mechanism (Yoshida et al teach that the reception is from a facsimile apparatus and the destination is also a facsimile apparatus (column 18, lines 53-56; column 18, lines 62-66)).

Regarding claims 18, 40, and 62, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51

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respectively. Further Yamamuro discloses an apparatus and method, wherein said controlling mechanism is configured to detect that said transfer communications machine is incapable of receiving said image information and to then stop receiving said image information from said sending communications machine (column 4, lines 20-37).

8. Claims 8, 9, 19, 30, 31, 41, 52, 53, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6587219 to Saito et al further in view of U.S. Patent No. 5818609 to Yamamuro further in view of U.S. Patent No. 6335966 to Toyoda.

Regarding claims 8, 30, and 52, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. However, Yoshida et al in view of Saito et al further in view of Yamamuro does not disclose an apparatus and method, wherein said controlling mechanism is configured to obtain a latest communications capability through said communications mechanism when transferring said image information and to update said registration mechanism with said latest communications capability.

Toyoda discloses an apparatus and method wherein said controlling mechanism is configured to obtain a latest communications capability through said communications mechanism when transferring said image information and to update said registration mechanism with said latest communications capability (column 15, lines 37-49, column 6, lines 39-42).

Yoshida et al, Saito et al, Yamamuro, and Toyoda are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the mechanism of updating with the latest communication capability as taught by Toyoda with the system of Yoshida et al in view of Saito et al further in view of Yamamuro.

The motivation to combine the reference is clear because any recent changes to the transfer machine has to be updated to the communication mechanism so that an accurate image transfer can be accomplished.

Regarding claims 9, 31, and 53, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. Further Toyoda discloses an apparatus and method, wherein said controlling mechanism is configured to obtain a latest communications capability through said communications mechanism at intervals of a predetermined time period and to update said registration mechanism with said latest communications capability (column 15, lines 37-49).

Regarding claims 19, 41, and 63, Yoshida et al in view of Saito et al further in view of Yamamuro further in view of Toyoda teach all the limitations of claims 8, 30, and 52 respectively. Further Yamamuro disclose an apparatus and method wherein said controlling mechanism is configured to determine whether said latest communications capability is sufficient to receive said image information (Yamamuro: column 4, lines 20-24) and stops receiving said image information from said sending communications machine when said latest communications capability is determined as not sufficient to receive said image information (Yamamuro: column 4, lines 28-37).

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9. Claims 13, 14, 35, 36, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6587219 to Saito et al further in view of U.S. Patent No. 5818609 to Yamamuro further in view of U.S. Patent No. 6816911 to Toyoda et al.

Regarding claims 13, 35, and 57, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. However Yoshida et al in view of Saito et al further in view of Yamamuro does not disclose an apparatus and method, wherein said controlling mechanism is configured to perform a retry call to said transfer communications machine upon a detection of an event indicating that said transfer communications machine is busy.

Toyoda et al disclose an apparatus and method, wherein said controlling mechanism is configured to perform a retry call to said transfer communications machine upon a detection of an event indicating that said transfer communications machine is busy (column 4, lines 51-58).

Yoshida et al, Saito et al, Yamamuro, and Toyoda et al are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the retry mechanism of Toyoda et al with the system of Yoshida et al in view of Saito et al further in view of Yamamuro.

The motivation to combine the reference is clear because if the transfer machine is only busy for a short time, a retry call can establish communication with the transfer machine quickly.

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Regarding claims 14, 36, and 58, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. Further Toyoda et al disclose an apparatus and method, wherein said controlling mechanism is configured to perform a retry call at intervals of a predetermined time period to said transfer communications machine upon a detection of an event indicating that said transfer communications machine is busy (column 1, lines 33-37).

10. Claims 17, 20, 39, 42, 61, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6587219 to Saito et al further in view of U.S. Patent No. 5818609 to Yamamuro further in view of U.S. Patent No. 6493103 to Toyoda et al.

Regarding claims 17, 39, and 61, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. However Yoshida et al in view of Saito et al further in view of Yamamuro does not disclose an apparatus and method further wherein said controlling mechanism is configured to transfer said image information through E-mail to said transfer communications machine.

Toyoda et al disclose an apparatus and method wherein said controlling mechanism is configured to transfer said image information through E-mail to said transfer communications machine (column 22, lines 5-10, lines 31-33, lines 48-61).

Yoshida et al, Saito et al, Yamamuro, and Toyoda et al are combinable because they are in the similar problem area of facsimile communication.



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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine e-mail transferring of data as taught by Toyoda et al with the system of Yoshida et al in view of Saito et al further in view of Yamamuro to implement an efficient image transferring system.

The motivation to combine the reference is clear because the option of using e-mail for transferring data is useful since image data can be compressed in e-mail format as taught by Toyoda et al (column 22, lines 58-61).

Regarding claims 20, 42, and 64, Yoshida et al in view of Saito et al further in view of Yamamuro further in view of Toyoda et al teach all the limitations of claims 17, 39, and 61 respectively. Yoshida et al in view of Saito et al further in view of Yamamuro further in view of Toyoda et al disclose an apparatus and method, wherein said controlling mechanism is configured to add a literal identification of said image information to said E-mail (Toyoda et al: column 22, lines 53-58).

11. Claim 21, 43, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6587219 to Saito et al further in view of U.S. Patent No. 5818609 to Yamamuro further in view of U.S. Patent No. 5959741 to Yoshida et al.

Regarding claims 21, 43, and 65, Yoshida et al (U.S. Patent No. 5696598) in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51. However Yoshida et al in view of Saito et al further in view of Yamamuro does not disclose an apparatus and method, wherein said controlling mechanism is configured to transfer said image

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information with a predetermined identification code causing said transfer communications machine to reproduce an output of said image information into a predetermined recording sheet tray corresponding to said predetermined identification code.

Yoshida et al (U.S. Patent No. 5959741) disclose an apparatus and method wherein said controlling mechanism is configured to transfer said image information with a predetermined identification code causing said transfer communications machine to reproduce an output of said image information into a predetermined recording sheet tray corresponding to said predetermined identification code (column 4, lines 19-25, lines 33-54).

Yoshida et al (U.S. Patent No. 5696598), Saito et al, Yamamuro, and Yoshida et al (U.S. Patent No. 5959741) are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the addition of code to facsimile transmission as taught by Yoshida et al (U.S. Patent No. 5959741) in the system of Yoshida et al (U.S. Patent No. 5696598) in view of Saito et al further in view of Yamamuro.

The motivation to combine the reference is clear because documents of different sizes have to be printed out differently at a destination.

12. Claims 12, 22, 34, 44, 56, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6587219 to Saito et al further in view of U.S. Patent No. 5818609 to Yamamuro further in view of U.S. Patent No. 5627658 to Connors et al.

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Regarding claims 22, 44, and 66, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. However Yoshida et al in view of Saito et al further in view of Yamamuro does not disclose an apparatus and method wherein said controlling mechanism is configured to determine whether an own communications capability can accept said image information and to transfer said image information to said transfer communications machine when said own communications capability of said apparatus cannot accept said image information.

Connors et al disclose an apparatus and method wherein said controlling mechanism is configured to determine whether an own communications capability can accept said image information and to transfer said image information to said transfer communications machine when said own communications capability of said apparatus cannot accept said image information (column 3, lines 15-27).

Yoshida et al, Saito et al, Yamamuro, and Connors et al are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the transferring mechanism taught by Connors et al in the system of Yoshida et al in view of Saito et al further in view of Yamamuro to implement a fast facsimile transmission system.

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The motivation to combine the reference is clear because time can be saved by finding another transfer facsimile machine when the designated machine is not available or busy.

Regarding claims 12, 34, and 56, Yoshida et al in view of Saito et al further in view of Yamamuro teach all the limitations of claims 7, 29, and 51 respectively. Further Connors et al disclose an apparatus and method wherein said controlling mechanism is configured to transfer said image information to another registered transfer communications machine upon a detection of an event indicating that said transfer communications machine is busy (column 3, lines 15-27).

13. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6493103 to Toyoda et al.

Regarding claim 69, Yoshida et al teach all the limitations of claim 67. However Yoshida et al does not disclose a method as in claim 67 in which said transferring is by e-mail transmission.

Toyoda et al disclose a method in which said transferring is by e-mail transmission (column 22, lines 5-10, lines 31-33, lines 48-61).

Yoshida et al and Toyoda et al are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the e-mail transmission taught by Toyoda et al into the facsimile transferring system of Yoshida et al.

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The motivation to combine the reference is clear because e-mail transmission provides for an alternate method of transferring facsimile data.

14. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 5801846 to Nobuta.

Regarding claim 70, Yoshida et al teach all the limitations of claim 67.

However

Yoshida et al does not disclose a method in which said checking comprises analyzing an initial portion of the fax transmission to see if a subsequent portion of the fax transmission contains color image information.

Nobuta discloses a method in which said checking comprises analyzing an initial portion of the fax transmission to see if a subsequent portion of the fax transmission contains color image information (column 12, lines 4-7).

Yoshida et al and Nobuta are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the color checking taught by Nobuta into the facsimile system of Yoshida et al to implement a color facsimile transferring system.

The motivation to combine the reference is clear because the content of facsimile image data is necessary to determine where the data will be transmitted.

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15. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 5818609 to Yamamuro.

Regarding claim 73, Yoshida et al teach all the limitations of claim 67. However Yoshida et al does not disclose a method including concurrently receiving said fax transmission at the receiving fax machine and transferring said fax transmission from the receiving to the transfer fax machine.

Yamamuro discloses a method including concurrently receiving said fax transmission at the receiving fax machine and transferring said fax transmission from the receiving to the transfer fax machine (Yamamura discloses a system wherein the host computer is the sending device (Figure 1, reference 13) and the fax system comprising of a control unit (Figure 1, reference 11; column 2, lines 15-17) transfers data to an address specified by host (column 4, lines 58-59). Further image reception from host computer is interrupted when memory full occurs and image in memory of fax system is transferred to address before completion of image reception (column 4, lines 36-37, lines 40-42, lines 54-56, lines 58-61)).

Yoshida et al and Yamamuro are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the concurrent facsimile transferring system of Yamamuro with the system of Yoshida et al to implement an efficient facsimile transmission system.

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The motivation to combine the reference is clear because the transfer machine can get data earlier instead of waiting till end of the reception.

16. Claims 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6335966 to Toyoda.

Regarding claim 74, Yoshida et al teach all the limitations of claim 67. Further Yoshida et al disclose a method including storing, at said receiving fax machine, contact information regarding one or more transfer fax machines that have color printing capabilities (column 5, lines 38-47). However Yoshida et al does not disclose a method of updating said contact information from time to time through an automated process.

Toyoda discloses a method of updating said contact information from time to time through an automated process (column 15, lines 37-49, column 6, lines 39-42).

Yoshida et al and Toyoda are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the updating system of Toyoda with the facsimile system of Yoshida et al to implement an accurate facsimile transferring system.

The motivation to combine the reference is clear because it is necessary to get the latest status of a transfer machine before transmitting data to the transfer machine.

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Regarding claim 75, Yoshida et al in view of Toyoda teach all the limitations of claim 74. Further Yoshida et al disclose a method in which said contact information comprises information regarding color information processing capabilities of said one or more transfer fax machines (column 5, lines 38-40).

17. Claim 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6335966 to Toyoda further in view of U.S. Patent No. 5627658 to Connors et al.

Regarding claim 76, Yoshida et al in view of Toyoda teach all the limitations of claim 74. Further Yoshida et al disclose a method in which said transferring includes selecting through automated process one of several transfer fax machines for which contact information is stored in the receiving fax machine (column 5, lines 55-62). However Yoshida et al in view of Toyoda does not disclose a method of determining if the so selected transfer fax machine is available and, if it is not, selecting another, available transfer machine from among those for which contact information is stored at the receiving fax machine.

Connors et al discloses a method of determining if the so selected transfer fax machine is available and, if it is not, selecting another, available transfer machine from among those for which contact information is stored at the receiving fax machine (column 3, lines 15-27).

Yoshida et al, Toyoda, and Connors et al are combinable because they are in the similar problem area of facsimile communication.



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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the selection and routing system of Connors et al with the system of Yoshida et al in view of Toyoda further in view of Connors et al to implement an efficient facsimile transferring system.

The motivation to combine the reference is clear because facsimile transferring time will be saved by finding alternate facsimile machine when the designated machine is busy.

Regarding claim 77, Yoshida et al in view of Toyoda further in view of Connors et al teach all the limitations of claim 76. Further Yoshida discloses a method in which the stored contact information includes information regarding color information handling capabilities of said one or more transfer fax machines (column 5, lines 38-45) and said selecting includes taking into account, through automated process, a relationship between said fax transmission and said color information processing capabilities (column 20, lines 6-11).

18. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6493103 to Toyoda et al.

Regarding claim 78, Yoshida et al teach all the limitations of claim 67. However Yoshida et al does not disclose a method in which said transferring includes adding, by the receiving fax machine, a subject line to the transferred fax transmission.

Toyoda et al disclose a method of adding, by the receiving fax machine, a subject line to the transferred fax transmission (column 22, lines 53-58).

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Yoshida et al and Toyoda et al are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of adding a subject to the transmission data as taught by Toyoda et al with the system of Yoshida et al.

The motivation to combine the reference is clear because the receiving system can get information about the content of the transferred data.

19. Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 5959741 to Yoshida et al.

Regarding claim 79, Yoshida et al (U.S. Patent No. 5696598) teach all the limitations of claim 67. However Yoshida et al (U.S. Patent No. 5696598) does not disclose a method in which said transferring includes adding, by the receiving fax machine a code to the transferred fax transmission designating a manner of handling prints of the transferred fax transmission at the transfer fax machine.

Yoshida et al (U.S. Patent No. 5959741) discloses a method in which said transferring includes adding, by the receiving fax machine a code to the transferred fax transmission designating a manner of handling prints of the transferred fax transmission at the transfer fax machine (column 4, lines 19-25, lines 33-54).

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Yoshida et al (U.S. Patent No. 5696598) and Yoshida et al (U.S. Patent No. 5959741) are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the addition of code to the transmission as taught by Yoshida et al (U.S. Patent No. 5959741) with the facsimile system of Yoshida et al (U.S. Patent No. 5696598).

The motivation to combine the reference is clear because facsimile data can have different formatting and thus there is a need to specify the formatting to a transfer facsimile machine.

20. Claim 80 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5696598 to Yoshida et al in view of U.S. Patent No. 6414759 to Ikegami et al.

Regarding claim 80, Yoshida et al teach all the limitations of claim 67. Further Yoshida et al disclose a method in which said checking comprises checking if the fax transmission includes color information on a page-by-page basis (column 19, lines 5-17). However Yoshida et al does not disclose a method of transferring to the transfer fax machine only pages of said fax transmission that contain color information.

Ikegami et al disclose a method of transferring to the transfer fax machine only pages of said fax transmission that contain color information (column 7, lines 3-7, lines 30-39).

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Yoshida et al and Ikegami et al are combinable because they are in the similar problem area of facsimile communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the color only transmission taught by Ikegami et al with the system of Yoshida et al to implement color only transfer system.

The motivation to combine the reference is clear because if the transfer machine only handles color data then only color transmission should be effected.

#### ***Other Prior Art Cited***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5745257 to Kato et al disclose a communication device.

U.S. Patent Application Publication No. U.S. 2001/0028643 A1 to Dlugos et al disclose facsimile machine with signal routing and data management.

U.S. Patent No. 5455687 to Fukui et al disclose method for data transfer between electronic filing systems using facsimile communications.

U.S. Patent No. 6859527 to Banks et al disclose image communication between sending system and receiving system using the internet.

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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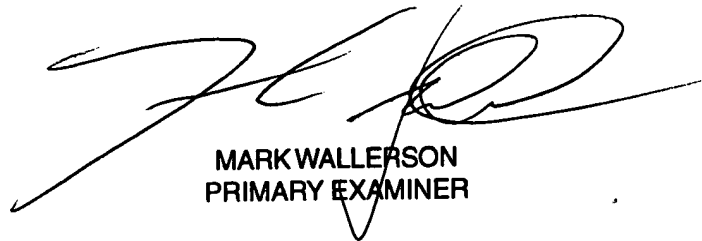
For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***Patent Examiner***

Beniyam Menberu

BM

08/07/2005



MARK WALLERSON  
PRIMARY EXAMINER